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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,736	06/22/2006	Frank Fiedler	20793/0204864-US0	9973
7278	7590	09/18/2008		
DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER CHANG, SUNRAY	
			ART UNIT 2121	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/596,736	<b>Applicant(s)</b> FIEDLER ET AL.	
	<b>Examiner</b> Sunray R. Chang	<b>Art Unit</b> 2121	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-27, 32-38, 43 and 44 is/are rejected.
- 7) ☒ Claim(s) 28-31 and 39-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20061127 20070216</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

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### ***Examiner's Detailed Office Action***

1. This Office Action is responsive to communication, filed on February 16<sup>th</sup>, 2007.  
Claims 1 – 22 have been cancelled, new claims 23 – 44 have been newly cited in the communication.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted to disclose 37 C.F.R. 1.56 all pertinent information and material pertaining to the patentability of applicant's claimed invention, on February 16<sup>th</sup>, 2007 and November 27<sup>th</sup>, 2006 have been considered by the examiner.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the modules of 61 (61a, 61b, 61c), 63 and 64 in fig. 3, 5, 7, 9, 12 and 13 must be clearly shown. The numerical indications can be found in the drawings, yet, it is not clear exactly if it is an icon or a display area only.

Clear drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be

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removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. **Claim(s) 23 – 26 is/are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kunio Toshimitsu et al. (U.S. Patent No. 6,133,561, and referred to as **Toshimitsu** hereinafter), and in view of Nicholas James Salmon et al. (U.S. P.G. Pub. No. 2003/0161515, and referred to as **Salmon** hereinafter).

**Regarding claim(s) 23,**

**Toshimitsu** teaches,

- An apparatus [an electric microscope, Abstract] comprising:
- an at least partially automated microscope [a control device which controls the drive of the electric revolver so as to stop the electric revolver at a rotational position in the midst of the change-over when it judges that either the objective lens currently on the optical path or an objective lens to be disposed on the optical path next is an immersion objective lens, based on an instruction from the instruction device, Abstract]
- including at least one configurable subassembly having at least one element, [an electric revolver, with a plurality of objective lenses mounted thereon, Abstract; fig. 5]
- the at least one element having a plurality of positions; [fig. 5A] and
- a controller associated with the microscope, [a control device which controls the drive of the electric revolver, Abstract]
- configurations of the at least one element for the at least one configurable subassembly; [positioning an objective lens corresponding to the instruction of the change-over switch on the optical path and the type of an objective lens to be disposed..., col. 13, lines 24 – 40]

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**Toshimitsu** teaches a controller to control, however, does not teach a computer for used to control the microscope which includes: a display, an input device, and a database configured to control;

**Salmon** teaches,

- a computer used for controlling microscope, [a computer controlled microscope is provided, Abstract; a controller preferably a computer ... controls the operation and/or status of the microscope, [0019]] including: a display, an input device, and a database [0019 – 0020] configured to store, for the purpose of controlling a microscope's settings and operations [0011].

It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the teaching of **Toshimitsu** to include “a computer for used to control the microscope which includes: a display, an input device, and a database configured to control”, for the purpose of controlling a microscope's settings and operations [0011].

Regarding **claim(s) 24, 26,**

**Toshimitsu** teaches the at least one configurable subassembly comprises,

- at least one of a motorized tube, an incident light axis, an objective nosepiece, a Z-drive for setting a focus, an X/Y-stage, a lamp, a condenser and a control knob. [revolver, A5, fig. 1]

Based on specification [0017] and fig. 1, [0035] and 112, fig. 12, the “revolver” in

**Toshimitsu** reference, is an “objective nosepiece” as claimed.

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Regarding **claim(s) 25**,

**Toshimitsu** teaches,

- the at least one configurable subassembly is automated. [electric revolver, Abstract]

Regarding **claim(s) 27**,

**Salmon** teaches,

- the display is configured to depict a plurality of user interfaces, each including at least three areas, [fig. 4 and fig. 5] for the purpose of controlling a microscope's settings and operations [0011].

Regarding **claim(s) 28 – 31 and 39 – 42**,

The limitations in **claim 28**, a first area of a first user interface of the user interfaces depicts a selection of at least three modules comprising “a first module providing a configuration of the microscope”, “a second, module providing a fine tuning” and “a third module providing an operation of the microscope”; the limitations can not be found in any reference so it would be allowable if re-structured in an independent form. Claims 29 – 31 depend on claim 28 would be allowable for the same reason.

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Regarding **claim(s) 32 and 43**,

**Toshimitsu** teaches,

- the computer is configured to calculate a process vector based on a first configuration of the at least one element and store the calculated process vector in a storage unit in a stand of the microscope. [control circuit controls the drive circuit based on a change-over instruction ... retate the motor in a predetermined direction, thereby positioning an objective lens corresponding to the instruction ... moves the stage to the fosing position of the objective lens disposed on the optical path, col. 13, lines 24 – 45]

Regarding **claim(s) 34**,

**Toshimitsu** teaches,

- A method for configuring an at least partially automated microscope including at least one configurable subassembly having at least one element having a plurality of positions, [see rejections to claim 23] the method comprising:
- and determining the at least one element so as to : configure the at least one subassembly; performing fine tuning of the at least one configured subassembly; and starting a measuring procedure with the microscope. [col. 15, lines 29 – 47]

**Salmon** teaches,

- depicting a user interface on a display of a computer associated with the microscope; [interface, fig. 5] selecting a first module for configuring the microscope; [a recording defines a sequence of operations and/or the status of a microscope and can be loaded and

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used to configure the microscope, [0002]] for the purpose of controlling a microscope's settings and operations [0011].

Regarding **claim(s) 35 – 37**,

Claims 35 – 37 have also been rejected, for the same reason as indicated above in the rejections to claims 24 and 25 since identical limitations are claimed. .

5. **Claim(s) 33, 38 and 44 is/are rejected** under 35 U.S.C. 103(a) as being unpatentable over **Toshimitsu** in view of **Salmon** and further in view of David E. Luzzi (U.S. Patent No. 5,225,999, and referred to as **Luzzi** hereinafter).

The combination of **Toshimitsu** in view of **Salmon** fails to teach a second display to provide a warning to a user in the case of incorrect combination.

**Luzzi** teaches warning means for informing a user [col. 4, lines 33 – 49]; entering commands through user interface, col. 8, lines 21 – 40] and [the warning means is an LED display, col. 10, lines 3 – 11] for the purpose of informing a user [col. 4, lines 33 – 49].

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### *Correspondence Information*

6. Any inquires concerning this communication or earlier communications from the examiner should be directed to Sunray Chang, who may be reached Monday through Friday, between 6:00 a.m. and 3:00 p.m. EST. or via telephone at (571) 272-3682 or facsimile transmission (571) 273-3682 or email [sunray.chang@uspto.gov](mailto:sunray.chang@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (571) 273-8300.

If attempts to reach the examiner are unsuccessful in the regular office hour, the Examiner's Supervisor, Albert Decady, may be reached at (571) 272-3819.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

Finally, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Moreover, status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free @ 1-866-217-9197.

***Sunray Chang***

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U.S. Patent & Trademark Office

/Albert DeCady/

Supervisory Patent Examiner, Art Unit 2121

September 18, 2008

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